

REMARKS

Claims 1-19 are pending in the application. Claims 1, 2, 12, 16 and 17 are rejected. Claims 3-9 and 18-19 are objected to but would be allowable if placed in independent form. Claims 14 and 15 are allowed. Claims 10, 11 and 13 are withdrawn from consideration on the basis of an election made by the Applicant. Applicant sincerely believes that all of the claims are patentable and has presented them as presently pending for the Examiner's convenience but without any amendment of the claims.

Restriction/Election

Claims 10-11 and 13 continue to be withdrawn from further consideration as being drawn to a non-elected species, the Examiner asserting that there being no allowable generic or linking claim. The Examiner notes that the election was made without traverse in Paper No. 5. The Examiner has corrected the error in the previous Office Action and now lists claim 15 as allowed.

Applicant continues to believe that these three claims should be considered allowable, in the present response and on appeal; thus, the claims have been retained.

Claim Rejections - 35 U.S.C. § 103

Claims 1-2, 12, 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki (6,488,582). This rejection is traversed for at least the following reasons.

On a substantive basis, Applicant previously argued that Suzuki does not render the claimed invention obvious for several reasons.

First, the Examiner admits that Suzuki does not increase the number of cards available at later battles on the basis of success in earlier battles. This is a clear difference under the *Graham* test of obviousness.

Second, there is no teaching or suggestion in Suzuki that such increased number of cards is contemplated or desirable. Suzuki clearly contemplates a game with only a limited number of cards, whether for simplicity or limited strategic capability.

Third, there is no demonstrated knowledge of one skilled in the art, or motivation to increase the number of cards to provide higher strength, rather than simply assigning a higher strength or power to an existing card. The Examiner continues to assert that an increase in battle power of a character by choosing an additional card signify higher strength, rather than storing new power on an original card, would be obvious because both approaches “increase the card’s power in the next battle sequence.”

In the Examiner’s response to Applicant’s previous amendment and argument at page 3 of the Office Action, the Examiner acknowledges that Applicant identified many reasons why the use of additional cards offers a patentable distinction. Those reasons include at least:

- the use of additional cards, rather than a single enhanced card, would provide different options to a player, as the player must correlate the multiple cards and determine the strategy on the basis of whether such multiple cards, or only a single card, should be played;
- in the actual process of playing the game, a limited number of cards may be delivered to or selected by a player, such that on the basis of random selection or a strategic purpose, a player may not have access to the additional cards;
- the nature of the additional cards may have an impact on only certain aspects of a character’s powers, for example magical, physical strength or weapons, and a player’s strategy may depend upon which of these features is to be enhanced; and
- the additional cards may be used for subsequent battles or game sequences.

The Examiner focuses only on the latter reason and states that the claims do not “say anything about the additional cards being available for other battles or even that these additional cards exist. This reasoning is flawed and ignores clear limitations in the claims.

- First, claim 1 expressly includes “a control device which increases the number of cards available in a battle.”
- Claim 2 expressly provides for the control device to cause “the player to advance to a next stage after having won over respective opposing characters in a certain stage, and increases the number of cards available in a battle.”
- Claim 12 expressly requires the step of “causing the player to proceed to the next stage when having won over the opposing characters in a certain stage, thereby increasing the number of cards available in a battle.”
- Claim 17 expressly requires “a processing routine for increasing the number of cards available in a battle when the player continues winning.”

Clearly, all of the claims recite the limitation that the Examiner asserts is missing from the claims and thus leads to the final rejection. In fact, the limitation that the Examiner seems to suggest would distinguish over the prior are is expressly recited in all of the rejected claims. Thus these claims should be allowable.

Finally, the Examiner's statement that "it may be assumed that the additional cards are created for use by the players in a battle with [sic which] includes the character who won the earlier battle. This would be the same as listing the attributes of the character on the same card." does not address the clear limitations in the claim that require a structure that increases the number of cards. The Examiner seems to be arguing that Suzuki would be obvious from the teachings of the Applicants. This is not the test for determining the obviousness of Applicants' invention from Suzuki. Moreover, even if that test were proper, the clear differences admitted by the Examiner, coupled with a lack of teaching or motivation, would lead to the unmistakable conclusion that the invention is not obvious over Suzuki. There are many reasons why increasing the number of cards, rather than increasing the power of a single card, would not be obvious to one skilled in the art. Thus, the rejection should be withdrawn.

Allowable Claims

Claims 2-9, 18 and 19 are objected to as being depended upon a rejected base claim but would be allowable if rewritten in independent form. Applicant is grateful to the Examiner for this indication of allowability.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.116
09/880,833

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

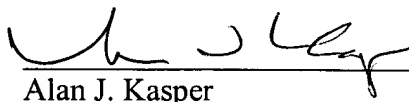
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